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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PIAZZA CORCORAN, GLADYS JOSEFINA

ART UNIT PAPER NUMBER

1733

DATE MAILED: 08/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS5

Office Action Summary

Application No.

09/992,902

Applicant(s)

ZURAW ET AL.

Examiner

Gladys J Piazza Corcoran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 4. 6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, drawn to a method of releasing laminates from one another, classified in class 156, subclass 289.
 - II. Claims 8-14, drawn to a release sheet, classified in class 428, subclass 532.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process such as placing the release sheet between a laminate and a mold in stead of between stacks of thermosetting synthetic resin-impregnated fibrous core sheets as require by the claims in Group I, or by using between thermoplastic resin impregnated sheets, etc..
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Daniel B Reece IV on August 11, 2003 a provisional election was made with traverse to prosecute the invention of Group I,

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claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claims 8-14 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5, 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hagen (US Patent No. 3,215,579).

Hagen discloses a method releasing laminates from one another in a heat and pressure consolidated press pack (column 1, lines 9-24) by arranging a plurality of thermosetting synthetic resin-impregnated fibrous core sheets in a superimposed relationship in groups of at least two stacks (column 2, lines 1-2, 26-53), separating the stacks from one another with a release sheet (column 2, lines 45-47) comprising a cellulosic based paper substrate (column 3, line 14) with a salt treatment of at least one surface of the substrate during formation of the substrate via the application to the

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surface of an aqueous solution comprising at least one water-soluble multivalent salt (column 3, lines 14-20; 52-57) in an amount sufficient to provide a solids content of about 0.01% to about 3% by weight based upon the dry weight of the substrate (column 3, lines 57-62) and the substrate is coated after formation on at least one salt-treated surface with a film comprising at least one salt of alginic acid (column 3, lines 65-70), consolidating the stacks of core sheets and release sheet by the application of heat and pressure and separating the resulting laminates from one another at the locus of the release sheet (column 2, lines 60-68).

As to the limitation that the salt treatment of at least one surface of the substrate is during the formation of the substrate, the reference Hagen is considered to fully meet this limitation since the substrate is still being "formed" by the application of the salt treatment and later a coating of a salt of alginic acid. Thus the application of the salt treatment is "during the formation of the substrate."

As to claim 2, Hagen discloses that the salt is applied in an amount sufficient to provide a solids content of about 0.05% to about 1% by weight based upon the dry weight of the substrate (column 3, lines 57-61). As to claim 3, Hagen discloses that the salt is applied in an amount sufficient to provide a solids content of about 0.1% to about .5% by weight based upon the dry weight of the substrate (column 3, lines 57-61). As to claim 4, Hagen discloses all the salts as claimed (column 3, lines 37-51). As to claim 5, Hagen discloses all the salts as claimed (column 3, lines 37-51). As to claim 7, Hagen discloses all the alginic acid salts as claimed (column 4, lines 12-15).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-5, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hagen (US Patent No. 3,215,579) in view of Bradner (US Patent No. 2,229,621).

The reference Hagen is cited as discussed above in paragraph 7. As stated above, the reference Hagen fully meets the limitation that the salt treatment of at least one surface of the substrate is during the formation of the substrate, since the substrate is considered to be formed while the additional coatings are still being applied. However, it appears in the Specification that the intent of Applicant is that the formation of the substrate to be while the substrate is still on the "machine". Consequently, the following rejection is cited for purposes of furthering the prosecution of the case.

Hagen discloses providing a sizing compound of a salt solution to the paper substrate (column 3, lines 51-62). It is unclear at what point of the formation of the paper substrate the sizing compound is applied, however it appears the sizing is applied once the paper substrate is in a web form. It is well known in the paper making arts to provide a sizing coating to a paper substrate while the paper substrate is still "on the forming machine" in order to reduce costs. For example, Bradner discloses a method of sizing a paper substrate with an aqueous coating composition where the sizing is applied "during the formation of the substrate" while the substrate is still "on machine" as an alternative to coating the sizing after formation of the substrate or "off-machine" in order to reduce time, labor and capital investment (column 1, lines 4-39). It is noted that one of the examples of sizing coatings that Bradner lists is a salt coating (calcium carbonate). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of forming the releasing laminate as shown by Hagen by coating the water soluble salt sizing during the formation of the paper substrate as is well known in the art as a cost saving alternative to coating off-machine as exemplified by Bradner.

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hagen (optionally in view of Bradner) as applied to claim 1 above, and further in view of Malhotra et al. (US Patent No. 6,171,702).

Hagen discloses that the water-soluble salt is selected from a wide variety of salts of common alkaline earth metals including salts derived from calcium (column 3, lines 37-51), however Hagen does not appear to specifically disclose calcium

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propionate as an example. It is well known in the art of coating paper substrates to use a variety of available calcium salts including calcium propionate. It would have been well within the purview of one of ordinary skill in the art at the time of the invention to select a well known salt for the method shown in Hagen. Furthermore, Malhotra discloses an example of a method of coating paper where the water soluble salt is a calcium propionate (column 4, lines 55-61). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of forming the releasing laminate as shown in Hagen (optionally Bradner) by selecting a well known calcium salt of calcium propionate as would have been well within the purview of one of ordinary skill in the art and further exemplified as known in the art of coating paper as exemplified by Malhotra, only the expected results would be attained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gladys J Piazza Corcoran whose telephone number is (703) 305-1271. The examiner can normally be reached on M-F 8am-5:30pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Ball can be reached on (703) 308-2058. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Gladys J Piazza Corcoran
Examiner
Art Unit 1733

GJPC
August 25, 2003